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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,639	11/15/2001	Masayuki Mishima	Q67304	7410

7590 05/11/2004

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,639

Applicant(s)

MISHIMA ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This Office action is in response to applicant's amendment filed February 02, 2004, which amends claims 1, 5, 6, 13, 17 and 18, and adds claims 25 and 26.

Claims 1-26 are pending.

2. This Office action is also in response to a terminal disclaimer and to a certified translation of applicant's foreign priority application JP 2000-350170 (11/16/2000), both filed February 02, 2004.

3. The published applications of Igarashi et al. (US 2002/0024293 A1) and Ise et al. (US 2002/0028329 A1) are withdrawn as prior art in view of the certified translation of applicant's foreign priority application. Accordingly, the rejections of claims 1-24 under 35 U.S.C. 102(e) based on these two documents are withdrawn.

The terminal disclaimer filed on February 02, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on copending Application No. 09/905,946, has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the provisional obviousness-type double patenting rejection set forth in the Office action mailed July 31, 2003 is overcome.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 4, 8-13, 15, 16 and 20-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by Baldo et al. in *Applied Physics Letters*, Vol. 75, No. 1, pp. 4-6 (July 5, 1999) or Baldo et al. (6,097,147) for reasons of record in the Office action mailed July 31, 2003.

6. Claims 2 and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Baldo et al. in *Applied Physics Letters*, Vol. 75, No. 1, pp. 4-6 (July 5, 1999) or Baldo et al. (6,097,147) as applied to claims 1, 3, 4, 8-13, 15, 16 and 20-24 and as evidenced by Lamansky et al. (US 2002/0182441 A1), for reasons of record in the Office action mailed July 31, 2003.

Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Baldo et al. in *Applied Physics Letters*, Vol. 75, No. 1, pp. 4-6 (July 5, 1999) or Baldo et al. (6,097,147) as applied to claims 1, 3, 4, 8-13, 15, 16 and 20-24 and as evidenced by Lamansky et al. (US 2002/0182441 A1) for the same reasons as claims 2 and 14 are rejected.

New claim 25 combines the limitations of claims 1-4. New claim 26 combines the limitations of claims 13-16.

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7. Claims 1-24 stand rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al. (US 6,461,747 B1) for reasons of record in the Office action mailed July 31, 2003.

8. Applicant's arguments filed February 02, 2004 have been fully considered but they are not persuasive with respect to the preceding prior art rejections.

With respect to the rejections based on Baldo's article or Baldo's patent, applicant argues that Baldo et al. do not disclose that the BCP in Baldo's structures acts as an electron-transporting material. This argument is not persuasive because the BCP, and the BCP layer, inherently transports electrons.

With respect to the rejection based on the Okada patent, applicant submits a statement to establish common ownership. A statement of common ownership is insufficient to overcome a rejection under 35 U.S.C. 102(e). See MPEP 706.02(I)(1):

35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory art under 35 U.S.C. 102, including 35 U.S.C. 102(e), is not affected, and may still be used to reject claims as being anticipated.

9. Miscellaneous:

In the penultimate line of each of claims 7 and 19, "an" should read --a--.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
May 06, 2004



MARIE YAMNITZKY
PRIMARY EXAMINER

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